REMARKS

STATUS OF THE CLAIMS

Claims 1, 3-8, 10-15, 17-22, and 24-26 remain in the case and stand rejected. Claims 1, 3-8, 10-15, 17-22, and 24-26 are rejected under 35 U.S.C. §103(a) as being unpatentable over "MSN Instant Messenger Protocol," April 23-27, 2002, printed from hypothetic.org, (hereinafter "*MSN*"), and additionally as being unpatentable over alleged "Admitted Prior Art in the Background section of the Specification," (hereinafter "*Related Art*"), in view of U.S. Patent number 7,024,209 to Gress *et al.* (hereinafter "*Gress*"). Claims 1, 8, 15, 22, and 26 are amended. Claims 2, 9, 16, and 23 have been previously cancelled. No claims have been added. The Applicants respectfully traverse these rejections in view of the amendments and the following remarks.

Claims 1, 8, 15, 22, and 26 are amended to clarify the claimed invention and to further prosecution. Amendments to independent Claims 1, 8, 15, 22, and 26 are supported in at least paragraphs [0001], [0004]-[0008], [0022]-[0026], and [0028] of the Specification.

RESPONSE TO CLAIM REJECTIONS UNDER 35 U.S.C. §103(a)

Claims 1, 3-8, 10-15, 17-22, and 24-26 are rejected under 35 U.S.C. §103(a) as being unpatentable over *MSN* for obviousness, and further for being unpatentable over the *Related Art* in view of *Gress* for obviousness. The Applicants respectfully submit that the Applicants' *Related Art* is not admitted prior art under *MPEP § 2129*. The Applicants further respectfully submit that *MSN* and further *Gress* do not render the claimed invention obvious because they do not teach each and every element of the claimed invention and because a Graham Factor analysis indicates non-obviousness.

The Applicants respectfully note at the outset that in order to establish a *prima facie* case of obviousness, it is the burden of the Examiner to clearly articulate the reason(s) why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made. *See MPEP § 2141.III.* As stated by the U.S. Supreme Court in *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007), the analysis supporting a rejection made under 35

U.S.C. § 103 should be made explicit. Moreover, the Court also stated in *KSR* that "…[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.* at 1740-1742.

The U.S. Supreme Court in *KSR* upheld the use of the Graham Factors to determine obvious, the Graham Factors being:

> (1) the scope and content of the prior art;
>
> (2) the differences between the prior art and the claimed invention;
>
> (3) the level of ordinary skill in the art; and
>
> (4) any relevant secondary considerations, such as commercial success, long-felt need, and the failure of others. See *KSR* at 1734; *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18, 86 S.Ct. 684, 15 L.Ed.2d 545.

The Applicants respectfully submit that an analysis of the Graham Factors, as mandated by *KSR* and *MPEP § 2141*, clearly shows that neither *MSN* nor *Gress* render the claimed invention obvious.

The Scope and Content of the Prior Art

The MSN Reference

The *MSN* reference seems to be an unofficial guide to the MSN Messenger protocol, patched together by "eavesdrop[ping] on communications between the MSN client and the server" using packet sniffers. (*MSN*, research_practice.php, ¶¶ 1-2). The *MSN* reference cited in the Office Action teaches two server message types, "the first one notifies you when a new email has been received. The second notifies you when an email has been deleted (or maybe something else also)." (*MSN*, connecting.php, ¶ 15).

In the *MSN* reference, chat data is sent as commands. (*MSN*, basics.php, "Commands"). The commands in the *MSN* reference are used to send chat messages, convey profile information or formatting information, and to request an IP address. (*MSN*, basics.php). The *MSN* reference does not teach receiving an activation message at a non-SMS mobile communications device,

determining whether an activation message comprises a server initiated action (SIA) message identifier, preventing display of the activation message to a user, parsing the activation message to locate the embedded initiation command, and automatically initiating an action from an activation message, as recited in the claims at issue.

The Gress Reference

The *Gress* reference teaches receiving, storing, and sending SMS messages according to an open standards-based protocol. (*Gress*, Abstract). *Gress* teaches that a server generates a common format message that includes an SMS message, so that the SMS message can be stored according to a different protocol, such as IMAP. (*Gress*, col. 2, line 60 – col. 3, line 8). The SMS message can then be accessed by SMS devices or non SMS-type devices. (*Gress*, Abstract).

Like the *MSN* reference, the *Gress* reference is silent on receiving an activation message at a non-SMS mobile communications device, determining whether an activation message comprises a server initiated action (SIA) message identifier, preventing display of the activation message to a user, parsing the activation message to locate the embedded initiation command, and automatically initiating an action from an activation message, as recited in the claims at issue.

The Applicants' Related Art

The Applicants maintain that the Applicants' *Related Art* is not admitted prior art under MPEP § 2129, as detailed in the previous Office Action Response sent May 22, 2009. However, even if, arguendo, the *Related Art* were admitted prior art, despite not being labeled as "prior art" as required by MPEP § 2129, the *Related Art* section does not teach "receiving an activation message at a non-SMS device over an IP-based messaging protocol, the non-SMS device comprising a mobile communications device that is unable to receive an SMS communication over a signaling system 7 ("SS7") signaling channel," "the action of the initiation command is auxiliary to the IP-based messaging protocol," "preventing display of the activation message to a user in response to the activation message comprising the SIA message identifier," "parsing the

activation message to locate the embedded initiation command in response to the activation message comprising the SIA message identifier," and "automatically initiating the action of the initiation command in the activation message in response to the activation message comprising the SIA message identifier," as recited in the claims at issue.

The *Related Art* teaches "the user then takes action to connect to the enterprise server to download and read the email" instead of automatically initiating an action contained in an SIA message, and further teaches that "for IP networks…there is no such thing as an SS7 signaling channel." (*Related Art*, ¶¶ [0003] – [0005]).

The Differences between the Prior Art and the Claimed Invention

In direct contrast to the prior art, amended Claim 1 is directed to "receiving an **activation message at a non-SMS device over an IP-based messaging protocol**, the non-SMS device comprising **a mobile communications device that is unable to receive an SMS communication over a signaling system 7 ("SS7") signaling channel**, the activation message **comprising a server initiated action ("SIA") message identifier and an initiation command embedded in the activation message**, the initiation command comprising an **action for execution on the non-SMS device**, wherein **the action of the initiation command is auxiliary to the IP-based messaging protocol**; determining whether the activation message comprises the SIA message identifier; **preventing display of the activation message to a user** in response to the activation message comprising the SIA message identifier; **parsing the activation message to locate the embedded initiation command** in response to the activation message comprising the SIA message identifier; and **automatically initiating the action of the initiation command** in the activation message in response to the activation message comprising the SIA message identifier," as recited in the claims at issue. (amended Claim 1, emphasis added). To further clarify the claimed invention, the Applicants have presently amended independent Claims 1, 8, 15, 22, and 26 to substantially recite the elements described above.

The Applicants respectfully submit that the *MSN* reference does not teach the elements of independent Claims 1, 8, 15, 22, and 26 as amended. The Office Action is silent on where the

MSN reference teaches "sending an **activation message** to said non-SMS device over an IP-based messaging protocol." (*Office Action*, pg. 6, ¶ 2). (Claim 1 is now amended to recite "*receiving* an activation message . . .") The Office Action further states that "*MSN* does not expressly disclose that the inherent device that receives the message is a 'non-SMS device.'" (*Office Action*, pg. 7, ¶ 1). The Office Action also states that "*MSN* does not disclose 'determining' whether received messages 'contain a server initiated action (SIA).'" (*Office Action*, pg. 7, ¶ 3). The Office Action goes on to state that "*MSN* does not expressly disclose, if the activation message contains an SIA message, configuring the receiving device to 'initiate an action contained in the SIA message.'" (*Office Action*, pg. 8, ¶ 1).

The Applicants agree with the Office Action that the *MSN* reference does not teach even one of the five elements of amended independent Claim 1. The Office Action seems to suggest that every element of independent Claim 1 is inherent, as *MSN* is silent on each of them. *MPEP § 2112.IV* provides the requirements to show inherency:

> The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" (emphasis added).

The Applicants respectfully submit that the Office Action does not establish that receiving an **activation message** at a **non-SMS device** over an **IP-based messaging protocol**, determining whether the activation message comprises a **server initiated action ("SIA") message identifier**, and **automatically initiating an action of an initiation command** in the activation message in response to the activation message comprising the SIA message identifier are necessarily present in the MSN messaging protocol taught in the *MSN* reference.

Additionally, the amended claims now recite that "the non-SMS device compris[es] **a mobile communications device that is unable to receive an SMS communication over a**

signaling system 7 ('SS7') signaling channel," "wherein **the action of the initiation command is auxiliary to the IP-based messaging protocol**," "**preventing display of the activation message to a user** in response to the activation message comprising the SIA message identifier," and "**parsing the activation message to locate the embedded initiation command** in response to the activation message comprising the SIA message identifier." (amended Claim 1, emphasis added).

The Applicants' present amendments are clearly not inherent in the *MSN* reference. The Office Action seems to equate the hotmail email notification of the *MSN* reference with the activation message of the claims at issue. The hotmail email notification clearly does not contain an SIA message, an SIA message identifier, or an initiation command that comprises an action for execution on the non-SMS device. The *MSN* reference does not teach "automatically initiating the action from the initiation command in said activation message." The Office Action suggests that "the claimed 'action' can be merely opening a browser using the 'Message-URL' and 'Post-URL' specified in the email notification." (*Office Action*, pg. 8, ¶ 2). The Office Action further suggests installing a browser so that a user could perform such an action. (*Office Action*, pg. 8, ¶ 3).

The Applicants respectfully submit that the hotmail notification of *MSN* does not contain an action contained in an SIA message, much less "automatically initiating the action of the initiation command in the activation message." The entirety of the hotmail notification is reproduced in the *MSN* reference and in the Office Action, and it clearly does not state "install a browser, open the browser, and display this URL in the browser" or any other action or command. (*Office Action*, pgs. 5-6). At most, the hotmail notification has an address or location, which is clearly not an action for execution on a non-SMS device. If such an action is literally and factually not present "in the thing described in the reference," it cannot be inherent, because it is not "necessarily present" as required by *MPEP § 2112*.

Further, the commands of the *MSN* reference are used to send chat messages, convey profile information or formatting information, and to request an IP address. (*MSN*, basics.php). In other words, the nuts and bolts of the chat system of the *MSN* reference are implemented as

chat commands sent back and forth between a server and a client. The initiation command in the claimed invention, however, is "**auxiliary to the IP-based messaging protocol**." (amended Claim 1, emphasis added). The claimed invention piggy-backs on an IP-based messaging protocol to send an initiation command by embedding the command in a chat message. The initiation command is not part of the messaging protocol, but the chat commands in the *MSN* reference are part of the messaging protocol. If a chat message has "a server initiated action ("SIA") message identifier and an initiation command **embedded in the activation message**," the chat message is processed separately, the claimed invention "**prevent[s] display of the activation message**," "**prevent[s] display of the activation message to a user**," and "**automatically initiat[es] the action of the initiation command**," all "**in response to the activation message comprising the SIA message identifier**." (Amended Claim 1, emphasis added).

The *MSN* reference is silent on any separate processing and on messages having any embedded identifiers or commands that are auxiliary to an IP-based messaging protocol, instead simply teaching certain chat commands to facilitate chat messaging. (*MSN*, basics.php). The *MSN* reference clearly does not teach or suggest the preventing, parsing, and initiating steps recited in the claimed invention, much less performed in response to an activation message with an embedded SIA message identifier.

Similarly, the Applicants respectfully submit that the *MSN* reference is also silent on "receiving an **activation message** at a **non-SMS device** over an **IP-based messaging protocol**, the non-SMS device comprising a **mobile communications device** that is **unable to receive an SMS communication over a signaling system 7 ("SS7") signaling channel**" as recited in the claims at issue. (Amended Claim 1, emphasis added). In direct contrast to the claimed invention, the *MSN* reference teaches a chat protocol for Microsoft's "commercial Instant Messaging product [released] in July of 1999 called MSN Messenger Service," a product released for the Microsoft Windows operating system. (*MSN*, ietf_draft.php). The Applicants respectfully submit that the *MSN* reference does not teach an IP-based messaging protocol for non-SMS mobile

communications devices that are unable to receive an SMS communication over an SS7 signaling channel.

The Applicants further respectfully submit that even if the *Related Art* was admitted prior art, neither the *Gress* reference nor the *Related Art* section teach "receiving an activation message at a non-SMS device **over an IP-based messaging protocol**, the non-SMS device comprising a **mobile communications device that is unable to receive an SMS communication over a signaling system 7 ("SS7") signaling channel**," "**the action of the initiation command is auxiliary to the IP-based messaging protocol**," "**preventing display of the activation message to a user in response to the activation message comprising the SIA message identifier**," "**parsing the activation message to locate the embedded initiation command in response to the activation message comprising the SIA message identifier**," and "**automatically initiating the action of the initiation command** in the activation message in response to the activation message comprising the SIA message identifier," as recited in the claims at issue. The Office Action again seems to rely on an inherency argument, stating that "it would have been obvious to one of ordinary skill in the art to utilize Gress' system to receive the SIA activation message and retrieve the email accordingly" without an analysis of specific elements of the claims at issue. (*Office Action*, pg. 12, ¶ 3).

In the claims at issue, the activation message comprises "a server initiated action ("SIA") message identifier and an initiation command embedded in the activation message, the initiation command comprising an action for execution on the non-SMS device." (Amended Claim 1). If the system taught in *Gress* was used to store **an activation message** from the claimed invention in an IMAP directory, or send it as a voice message, fax, e-mail, or the like as taught in the *Gress* reference, the activation message with the embedded SIA message identifier and initiation command would be unintelligible to a user.

For example, in paragraph [0025] of the Specification, an example SIA message identifier and initiation command suitable for embedding within a chat message is "x-ibm-sia:010402,k01400208020." If the *Gress* reference was combined with the *Related Art* as

suggested in the Office Action, users would receive a voice message, fax, e-mail, or the like stating only "x-ibm-sia:010402,k01400208020" every time an activation message was received.

The claimed invention recites "preventing display of the activation message to a user" for that very reason, because the activation message is not a standard chat message, but is a command that is "auxiliary to the IP-based messaging protocol." (Amended Claim 1). Such a forced reading is clearly not necessarily present in *Gress* as required by *MPEP § 2112*, and would further destroy the utility of both the invention and the *Gress* reference if combined, even if the *Related Art* was admitted prior art.

Graham Factors Indicate Non-Obviousness

As described above, a Graham Factor analysis, specifically the scope of the prior art and the differences between the art and the claimed invention, leads to a clear conclusion that the claimed invention is nonobvious in view of *MSN* and in view of *Gress* and the Applicants' *Related Art*. The Applicants respectfully submit that the prior art fails to teach or suggest, either expressly or inherently, "receiving an **activation message at a non-SMS device over an IP-based messaging protocol**, the non-SMS device comprising **a mobile communications device that is unable to receive an SMS communication over a signaling system 7 ("SS7") signaling channel**, the activation message **comprising a server initiated action ("SIA") message identifier and an initiation command embedded in the activation message**, the initiation command comprising an **action for execution on the non-SMS device**, wherein **the action of the initiation command is auxiliary to the IP-based messaging protocol**; determining whether the activation message comprises the SIA message identifier; **preventing display of the activation message to a user** in response to the activation message comprising the SIA message identifier; **parsing the activation message to locate the embedded initiation command** in response to the activation message comprising the SIA message identifier; and **automatically initiating the action of the initiation command** in the activation message in response to the activation message comprising the SIA message identifier." (Amended Claim 1, emphasis added).

The Applicants further submit that although the remarks have focused specifically on the limitations of independent Claim 1 as representative of similar limitations in independent Claims 8, 15, 22, and 26, that independent Claims 8, 15, 22, and 26 contain further limitations that are patentably non-obvious. For example, independent Claim 26 recites "automatically execut[ing] instructions from the chat message **to activate the non-SMS device** in response to the chat message comprising the SIA message identifer; and **activating the non-SMS device by sending a chat message to the non-SMS device**, the chat message comprising **an initiation command to activate the non-SMS device** to automatically perform an action contained in the chat message." (Claim 26, emphasis added). The Applicants respectfully submit that the cited art does not teach activating a non-SMS mobile communications device by sending an SIA chat message including instructions to activate the non-SMS device.

For at least the reasons outlined above, the Applicants respectfully submit that independent Claims 1, 8, 15, 22, and 26 are patentable over *MSN*, and over *Gress*, and further that dependent Claims 3-7, 10-14, 17-21, and 24-25 are also patentable for depending on an allowable claim. *See in re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). The Applicants respectfully request that the rejections to Claims 1, 3-8, 10-15, 17-22, and 24-26 under 35 U.S.C. § 103(a) be removed.

Applicants have amended Claims 1, 8, 15, 22, and 26 and cancelled Claims 2, 9, 16, and 23 from further consideration in this application. Applicants are not conceding in this application that those claims are not patentable over the art cited by the Examiner, as the present claim amendments and cancellations are only for facilitating expeditious prosecution of the allowable subject matter noted by the Examiner. Applicants respectfully reserve the right to pursue these and other claims in one or more continuation and/or divisional patent applications.

Should additional information be required, the Examiner is respectfully asked to notify the Applicants of such need. If any impediments to the prompt allowance of the claims can be resolved by a telephone conversation, the Examiner is respectfully requested to contact the undersigned.

Respectfully submitted,

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